

REMARKS

In the Office Action mailed December 17, 2003, the Examiner noted that claims 1 and 3-15 were pending, allowed claims 7, 9 and 10, and rejected claims 1, 3-7, 8 and 11-14. Claims 1, 3-5, 8 and 11-14 have been amended, new claims 15-20 have been added and, thus, in view of the forgoing claims 1 and 3-20 remain pending for reconsideration which is requested. No new matter has been added. The Examiner's rejections and objections are traversed below.

Request For Withdrawal of Action and Finality Of Action And Clarification of Action

In the Office Action on page 2, the Examiner rejected claims 1, 3-6, 8 and 11-14, particularly including claim 13, under 35 USC section 103 over Eick and Hayashi. In the discussion of the rejection the Examiner provided comments indicating the basis for rejection of all claims except claim 13. The CFR Rule and the MPEP governing whether an action can be made final state:

CFR Rule
37 CFR 1.113 Final rejection or action

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(b) In making such final rejection, the examiner shall repeat or state all grounds of rejection then considered applicable to the claims in the application, clearly stating the reasons in support thereof.

MPEP
706.07 Final Rejection [R-1]

Before final rejection is in order a clear issue should be developed between the examiner and applicant.

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STATEMENT OF GROUNDS

In making the final rejection, all outstanding grounds of rejection of record should be carefully reviewed, and any such grounds relied on in the final rejection should be reiterated. They must also be clearly developed to such an extent that applicant may readily judge the advisability of an appeal unless a single previous Office action contains a complete statement supporting the rejection.

The Examiner has not stated the grounds of rejection for claim 13 as required by Rule 1.113. A clear issue has not been developed between the Examiner and applicant because all grounds for the rejection, particularly for the rejection of claim 13, have not been stated as required by MPEP 706.07.

Withdrawal of the finality of the rejection and the issuance of a new Office Action addressing claim 13 is requested.

On page 4 the Examiner rejected claim 13 for the use of the word "scanning" and rejected claim 14 based on it's "dependence on rejected claim 13." However, claim 14 also uses the term "scanning". As a result, the status of claim 14 is not clear, and withdrawal of the finality of the rejection and clarification of the status of claim 14 via a newly issued Action is requested.

On pages 4 and 5 of the Office Action, the Examiner alleged that a feature relied upon by the applicant "frequency of occurrence of the character strings" is not recited in the rejected claims. Contrary to the allegation of the Examiner this particular phrase appears in claim 13. Given that the Examiner has apparently inadvertently ignored this claim language in issuing the Office Action, the Examiner is requested to withdraw the Action and issue an Action that considers the language of claim 13.

Rejection Under 35 USC Section 112, 1st Paragraph

On page 4 of the Action the Examiner rejected claim 13 under 35 U.S.C. section 112, paragraph 1 for failure to comply with the enabling requirement alleging that "scanning an input source for target character strings" (underlining emphasis supplied by the Examiner) as recited in claim 13 is not described in the specification. Claim 13 has been amended to address this issue and it is submitted that claim 13 satisfies the requirements of the statute. Withdrawal of the rejection is requested.

Rejection over Eick and Hayashi

Page 2 of the Office Action rejects claims 1, 3-6, 8 and 11-14 under 35 U.S.C. § 103 over Eick and Hayashi. As noted above the Examiner provided no comments about claim 13 and clarification of the basis for the rejection of claim 13 is requested.

The present invention is directed at color highlighting text character strings found in an input source. This highlighting can be based on colors selected by each individual user for each of the text strings, based on the frequency of occurrence of the strings in the input source, based on the commonality of the strings within different input sources and based on a change in position of the strings within the source. This allows a user to rapidly identify areas of interest in an input source containing the character strings. The input sources can be different types of documents.

Eick is directed to a system that displays telephone numbers of a telephone switch as nodes in a graph type display and displays telephone calls to the telephone numbers of the switch as lines or edges connected to the numbers. Statistics about the telephone numbers, such as number of telephone calls made by the node, determine the size of the node and

statistics about the telephone calls, such as the number of telephone calls between nodes, determine the size/width of the line between nodes. The display is produced by a program and the interactive execution of the program can be controlled by a keyboard or mouse. As discussed in column 8, the nodes are represented as node identifiers and statistics are described as values. The description does not address whether the identifiers or the values are character strings. They need not be and could, for example, be non-character-string representations, such as binary.

In the rejection, the Examiner argues that Eick discloses input and comparison of character strings. As noted above, Eick compares node identifiers and values for telephone numbers and telephone statistics and does not compare character strings.

Hayashi is directed to a system that reads an electronic spread sheet or table type document to determine the numeric value in the contents of cells of a table and if the numeric value is a specific value the cell is colored. Hayashi also discusses analyzing a graph type document to find a pie chart or graph so that the chart can be colored when it is printed. This technique requires the user to mark the graph with a special pen type marker that allows the graph to be detected when the paper containing the graph is scanned for the marker "ink".

Hayashi, like Eick, does not identify character strings but rather identifies numeric spread sheet cell values or marks by a user.

The combination of Eick and Hayashi does not teach or suggest comparing character strings of an input as in the present invention. In addition the present invention assigns colors to the identified character strings. Neither Eick or Hayashi teach or suggest assigning character strings a color. Further, the present invention does the character string comparison based on plurality of comparison criteria. The prior art of Eick and Hayashi compares based on a single criteria: telephone number in Eick, specific numeric cell value in Hayashi or user made special ink mark in Hayashi. These features of the present invention are emphasized in independent claims 1, 11, 12, and 13.

It is submitted that the invention of the independent claims distinguishes over the prior art and withdrawal of the rejection is requested.

The dependent claims depend from the above-discussed independent claims and are patentable over the prior art for the reasons discussed above. The dependent claims also recite additional features not taught or suggested by the prior art. For example, claim 8 emphasizes the relatedness of character strings as defining the assigned color. The prior art does not teach or suggest such. It is submitted that the dependent claims are independently patentable over

the prior art.

New claim 15 emphasizes that plural users are allowed to designate colors for color strings, that the system analyses the input for the strings and then displays the input to the user in the color designated by that particular user. That is the invention allows multiple users to designate strings and then have them displayed to the user in the users preferred color. This allows different users to emphasize different strings in the users preferred way. The prior art does not teach or suggest such. Claims 16-20 emphasize that a user can specify an analysis relationship for input character strings where the input strings are analyzed based on the relationship and the strings are displayed with colors according to the degree of the relationship found. The relationships include frequency of occurrence, common occurrence in plural input sources, change of position of the strings within the input source and a designation of one or more character strings by the user. Analysis of character strings using an analysis relationship is not taught or suggested by the prior art. It is submitted that these new claims, which are different and not narrower than prior filed claims distinguishes over the prior art.


It is submitted that the claims are not taught, disclosed or suggested by the prior art. The claims are therefore in a condition suitable for allowance. An early Notice of Allowance is requested.

If any further fees, other than and except for the issue fee, are necessary with respect to this paper, the U.S.P.T.O. is requested to obtain the same from deposit account number 19-3935.

Respectfully submitted,

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